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10/775,091	02/11/2004	Koichiro Suzuki	03500.017904.	1187
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EXAMINER				
RODRIGUEZ, LENNIN R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,091

Applicant(s)

SUZUKI, KOICHIRO

Examiner

LENNIN R. RODRIGUEZ

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007 and 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/16/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/12/2007.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- (1) 101 and 301 in Fig. 8;
- (2) 101, 201 and 301 in Fig. 9;
- (3) 101, 201, 301 and 401 in Fig. 10.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-8, 10-13, 19-21, 24-26 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Mukai (US 6,466,329).

(1) regarding claims 1 and 19:

Mukai '329 discloses an image forming system (Fig. 1) comprising:

image forming means that forms an image relating to subject data on a recording medium having holding means that holds identification information specific to the recording medium (column 4, lines 64-67 and column 5, lines 1-3, where the assigned page ID is printed on the page that would have the identification information);

detecting means that detects the identification information held by the holding means of the recording medium (column 6, lines 63-67, where the scanner detects the ID from the paper);

database means (column 6, lines 56-58, database server) that, in accordance with an image forming operation for an image relating to desired subject data by the image forming means, stores first identification information, which is detected by the

detecting means from the holding means of a first recording medium on which the image relating to the desired subject data is recorded (column 6, lines 65-67 and column 7, lines 1-7, where the database stores information about the identification of the image data), and the desired subject data in association with each other (column 7, lines 2-7, printing data associated with the page ID);

retrieving means that retrieves subject data corresponding to second identification information detected by the detecting means from plural subject data stored in the database means at a timing independent from the image forming operation for the image relating to the desired subject data (column 10, lines 34-41, where the scanner identifies another page ID (second identification information) and retrieves its information from the database server); and

control means that controls, in accordance with a result of the retrieval by the retrieving means, the image forming means to form an image relating to the subject data corresponding to the second identification information retrieved by the retrieving means on a second recording medium different from the first recording medium (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device).

(2) regarding claims 2 and 20:

Mukai '329 further discloses storing means that stores the plural subject data (column 6, lines 52-55, external storage); and

selecting means that is capable of selecting the desired subject data from the plural subject data stored in the storing means (column 6, lines 65-67 and column 7, lines 1-7, where the information related to certain searched ID is retrieved).

(3) regarding claims 3, 7, 21 and 25:

Mukai '329 further discloses wherein at least a part of the image forming means, the detecting means, the storing means, the selecting means, the database means, and the retrieving means are connected via a network (column 6, lines 56-59).

(4) regarding claims 6 and 24:

Mukai '329 further discloses wherein the subject data includes image data (column 8, lines 57-61).

(5) regarding claims 8 and 26:

Mukai '329 further discloses wherein the database means further stores additional information, which is related to the image forming operation of the image of the subject data, in association with the subject data (column 6, lines 63-64 and column 7, lines 1-9, where the PDL data describes the original image, and the original image quality is ensured), and

the retrieving means retrieves the subject data corresponding to the additional information in the case where information identical with the additional information is inputted at a timing independent from the image forming operation (column 10, lines 34-41, where the scanner identifies another page ID (second identification information) and retrieves its information from the database server and column 7, lines 3-7, where if the scanned image is found in the external storage, the image just captured is discarded and instead the saved one is retrieved).

(6) regarding claims 10 and 28:

Mukai '329 further discloses wherein the database means further stores, in accordance with the image forming operation for the image of the retrieved subject data by the image forming means, identification information (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server), which is detected by the detecting means from the holding means of the second recording medium on which the image relating to the retrieved subject data is recorded (71 page ID recognizer Fig. 1), and the retrieved subject data in association with each other (column 10, lines 38-41, where the data retrieve is associated with the page ID).

(7) regarding claims 11 and 29:

Mukai '329 further discloses an image forming system (Fig. 1) comprising:

image forming means that forms an image relating to subject data on a recording medium having holding means that holds identification information specific to the recording medium (column 4, lines 64-67 and column 5, lines 1-3, where the assigned page ID is printed on the page that would have the identification information);

detecting means that detects the identification information held by the holding means of an arbitrary recording medium on which an image is recorded (column 6, lines 63-67, where the scanner detects the ID from the paper); and

control means that acquires subject data corresponding to the identification information detected by the detecting means and controls the image forming means to form an image relating to the acquired subject data on the recording medium (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device).

(8) regarding claims 12 and 30:

Mukai '329 further discloses wherein the control means includes retrieving means that retrieves the subject data corresponding to the identification information, which is detected by the detecting means, from plural subject data stored in storing means (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server).

(9) regarding claims 13 and 31:

Mukai '329 further discloses wherein the detecting means detects identification information from the holding means in a non-contact manner (page ID recognizer 17 in Fig. 7, and it is inherent that barcodes are read in a non-contact manner).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-5 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) in view of Kohno (US 5,042,619).

(1) regarding claims 4 and 22:

Mukai '329 further discloses a detection unit in the vicinity of a moving path of the recording medium having in the image forming operation (page ID recognizer 71 in Fig. 1) and a recording medium brought close to the image forming means (column 10, lines

34-41, where a page is being brought to the scanner so that the ID information can be obtained).

Mukai '329 discloses all the subject matter as described above except wherein the detecting means includes a first detection unit for detecting the first identification information and a second detection unit for detecting the second identification information, and

the first detection unit is provided in the vicinity of a moving path, and the second detection unit is provided at a position where the second detection unit can read out the second identification information in the case where the recording medium is brought close.

However, Kohno '619 teaches wherein the detecting means includes a first detection unit for detecting the first identification information and a second detection unit for detecting the second identification information (column 4, lines 36-51, where the device (in this case cash register) contains 2 bar code reader as can be seeing in Fig. 4, which are capable of detection identification information from two different objects), and

the first detection unit is provided in the vicinity of a moving path (30 in Fig. 4, where the bar code scanner is in the vicinity of the moving path), and the second detection unit is provided at a position where the second detection unit can read out the second identification information in the case where the recording medium is brought close (34 in Fig. 4, where if a person desires to take a product from the moving path and scan it in the second bar code reader, its possible because both of them read the same information).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to detecting units for detection of identification information and that each of the detection devices are in different positions of the system as taught by Kohno '619 in the system of Mukai '329. By adding two bar codes to the system of Mukai '329 instead of one, to increase the chances of getting a read of the ID information from the recording medium as well as to make the system user friendlier by allowing the user to choose what is the easiest way to scan a page and still obtain the information.

(2) regarding claim 5 and 23:

Mukai '329 further discloses wherein at least one of the first detection unit and the second detection unit detects identification information from the holding means of the recording medium in a non-contact manner (page ID recognizer 17 in Fig. 7, and it is inherent that barcodes are read in a non-contact manner).

7. Claims 9 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) in view of Bontempi (US 2003/0137689).

(1) regarding claims 9 and 27:

Mukai '329 discloses all the subject matter as described above except wherein the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data.

However, Bontempi '689 teaches wherein the additional information includes identification information of an apparatus and application software which executed the

image forming operation for the image of the subject data (paragraph [0033], where the information received includes printer identification field and a printer driver which executed the image forming operation).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data as taught by Bontempi '689 in the system of Mukai '329. This enhances the capabilities of the system by allowing it to specify which printer and which software to use for the creation of the image print out.

8. Claims 14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) in view of Teraura (US 2002/01709730).

(1) regarding claims 14 and 32:

Mukai '329 discloses all the subject matter as described above except wherein the holding means includes an RFID tag.

However, Teraura '730 teaches wherein the holding means includes an RFID tag (abstract).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is convenient that a software is delivered with its manual in one body. Thus, it is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

Lennin Rodriguez
3/13/08